

**REMARKS**

1. Examiner objects to claim 15 as being of improper dependent form. Claim 15 is amended to correct the error.

2. Claims 5-15 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

This basis for rejection was previously withdrawn and is now again imposed. Examiner argues that the "selecting steps may be limited to the mind of the human user, without any physical manifestation of a real-world effect," which is similar to the argument previously made by Examiner.

The Board of Patent Appeals and Interferences has made it clear in a *per curiam* decision that business method claims are eligible for patenting even if not tied to the "technological arts" (Ex Parte Lundgren, No. 2003-2088, November 5, 2005, on application 08/093,516). The particular issue decided was whether there is a separate "technological arts" test for determining if a claim is statutory under 35 U.S.C. §101. The Board found that there was no such "mental steps" limitation to patentability.

Thus, the rejection of claims 5-15 under 35 U.S.C. §101 is improper.

Notwithstanding that claims 5 through 15 are patentable in a §101 sense, claims 5 and 14 have been amended to recite the final step of "generating an output indicating whether work can begin on the particular ship on the specified ILS date" which in itself should provide sufficient post-calculation activity for patentability.

3. Claims 5-15 are rejected under 35 U.S.C.

§103(a) as unpatentable over applicant's admitted prior art (AAPA) as disclosed in the "Background of the Invention".

Examiner argues that AAPA discloses a method comprising the steps of

"generating a change document in response to a perceived problem associated with a particular type of equipment (Page 1, lines 9-12; Page 4, lines 12-26)" which is clearly not the case. The Background of the Invention does not appear to include the word "change" at all, nor does it mention a "change document." Examiner appears to conflate a "change document" with an upgrade of the technical manuals associated with the upgraded equipment, which is mentioned at page 4, lines 12-26. The term "change document" is described in the specification at page 5, lines 21-26 as being

"...for correcting at least some perceived problems associated with a particular type of equipment . . ."

It is also defined at page 8, line 21 to page 9, line [ ] as

"The change product document is prepared by an engineer or engineering team in response to a perceived deficiency in the nature of the ship or other asset. Such a deficiency might be premature degradation of some item of machinery, electronics or software, or it might represent an enhancement of the performance of some item such as a radar system. The change document includes a title of the change document, a rough solution to the perceived problem, the identification of the system which is impacted, and includes the estimated cost, and also includes much other information, such as description of the

problem, drawings which must be changed, proposed vendors for the various parts, and the like."

There is no suggestion in the "Background of the Invention" that the technical manuals are the same as the "change document," and no basis appears for treating them as being the same.

Examiner goes on in relation to the §103 rejection to state that AAPA describes a method comprising the steps of

"associating said change document with those ships having said particular type of equipment"

"associating the particular ship upgrade with the change document for that particular ship upgrade"

"determining arrival dates of all elements associated with the particular upgrade associated with the change document"

which clearly cannot possibly be found in the "Background of the Invention" since it makes no mention whatever of "change document" or even the word "change." There is not a scintilla of evidence linking the recitations of independent claims 5 and 14 to the "Background of the Invention." Examiner has essentially deemed the claimed methods to be obvious in view of the matter in the "Background of the Invention." The rejection of claims 5-15 under §103 must fail.

4. Reconsideration and allowance are requested of claims 5-7 and 9-15.

3. No fee is believed to be required for this amendment. Please charge any other fees to deposit account

50-2061.

FOR THE APPLICANT(S)

by 

William H. Meise  
Attorney for Applicant  
Reg. No. 27,574

Duane Morris LLP  
P.O. Box 5203  
Princeton, NJ 08543-5203  
609-631-2453